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The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* ROBERT E. ARBOGAST, MICHAEL EDWARD HOPKINS,
JAMES M. COLVIN, MARK WILLIAM FORD,
PHILLIP LEE HARRISON, RAYMOND FRANCIS,
KEITH W. JUSTUS, REBECCA L. HALLEY,
BRADLEY A. SPITZER, THOMAS D. CHAMBERLAIN, and
ERIC L. KERSHNER

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Appeal 2009-009449
Application 09/893,535
Technology Center 3600

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

Robert E. Arbogast, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-39, 46-49, 65-69, and 80-82. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.[2]

## THE INVENTION

The invention relates to "configuring a medical device based on minimal input patient information." Specification [0001].

Claims 1, 31, and 46 reproduced below, are illustrative of the subject matter on appeal.

1. A system for configuring a medical device, comprising:
a digital repository populated with entries defining a plurality of medical device components, each entry associated with an individual medical device component and having
a component identification indicator,
a component class indicator, and
at least one patient attribute indicator;
a processor; and
a computer readable medium encoded with processor readable instructions that when executed by the processor implement
a practitioner user interface mechanism configured to provide a practitioner with access to entries in the digital repository via a

[2] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.", filed Jun. 18, 2007) and Reply Brief ("Reply Br.", filed Nov. 26, 2007), and the Examiner's Answer ("Answer", mailed Sep. 24, 2007).

network and to allow the practitioner to provide at least one patient interview answer indicator,

a patient interview mechanism configured to receive over the network the at least one patient interview answer indicator corresponding to an attribute of a patient and to store the at least one patient interview answer indicator in a memory, and

a configurator mechanism configured to select a subset of entries from the digital repository based on the at least one patient interview answer indicator in the memory, the subset of entries including entries corresponding to individual medical device components that collectively form a medical device meeting a need of the patient.

31. A method for configuring a medical device, comprising the steps of:

populating a digital repository with information corresponding to a plurality of medical device components;

interviewing a patient having a need for a medical device to determine at least one patient attribute;

storing the at least one patient attribute in a memory; and

querying the digital repository for a subset of medical device components based on the at least one patient attribute, the subset of medical device components collectively forming a medical device meeting the need of the patient.

46. A system for configuring a medical device, comprising:

means for populating a digital repository with information corresponding to a plurality of individual medical device components;

means for interviewing a patient having a need for a medical device to determine at least one patient attribute;

means for storing the at least one patient attribute in a memory; and

means for querying the digital repository for a subset of medical device components based on the at least one patient attribute, the subset of medical device components collectively forming a medical device meeting the need of the patient.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|---|---|---|
| Clynch | US 6,463,351 B1 | Oct. 8, 2002 |
| DeBusk | US 6,581,204 B2 | Jun. 17, 2003 |
| Haller | US 2001/0051787 A1 | Dec. 13, 2001 |
| Vanker | US 2002/0099631 A1 | Jul. 25, 2002 |

The following rejections are before us for review:

1. Claims 31-37, 39, 46-48, 65-67, and 82 are rejected under 35 U.S.C. § 102(e) as being anticipated by Clynch.
2. Claims 1-5, 8-14, 16, 19, 20, 22-30, and 80-81 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clynch and DeBusk.
3. Claims 38 and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Vanker.
4. Claims 68 and 69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Haller.
5. Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Vanker.
6. Claims 15, 17, 18, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Haller.

## ISSUES

The first issue is whether claims 31-37, 39, 46-48, 65-67, and 82 are anticipated under 35 U.S.C. § 102(e) by Clynch. Specifically, the issue is whether Clynch describes a step of interviewing a patient to determine at least one patient attribute and querying a digital repository for a subset of

medical device components based on the at least one patient attribute or means for performing these steps. The rejection of claims 38 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Vanker and the rejection claims 68 and 69 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Haller also turn on this issue.

The second issue is whether claims 1-5, 8-14, 16, 19, 20, 22-30, and 80-81 are unpatentable under 35 U.S.C. § 103(a) over Clynch and DeBusk. Specifically, the issue is whether Clynch teaches a patient interview mechanism and a configurator mechanism as recited in claim 1. The rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Vanker and the rejection of claims 15, 17, 18, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Haller also turn on this issue.

## FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Clynch's column 5, lines 1-6 states "In accordance with the method, the process of constructing a medical device begins in a physician's clinic 10 where in a step 20, a modeling material is fitted to the body part of a patient requiring a medical device. As described above, the medical device may be a prosthetic, orthotic, radiological or any other anthropometric precision fit device."

2. Clynch's column 7, lines 14-44 and 61-65 describes modifying a scanned image of a model body part, by selecting default modification options, which are stored in a database, from a pull down depending on the type of medical device to be produced.

## ANALYSIS

*The rejection of claims 31-37, 39, 46-48, 65-67, and 82 under 35 U.S.C. § 102(e) as being anticipated by Clynch.*

Independent claims 31 and 65 both recite a method which includes steps of "interviewing a patient having a need for a medical device to determine at least one patient attribute" and "querying the digital repository for a subset of medical device components based on the at least one patient attribute." The Appellants argue that Clynch does not describe this step. App. Br. 10 and Reply Br. 5-6. The Appellants state:

> Clynch teaches only that a practitioner interacts with a patient during the casting and scanning of the patient's residual limb. There is no teaching that the practitioner interviews the patient, formally or otherwise, to obtain at least one patient attribute that will be subsequently used in the configuration and selection of a prosthesis. Rather, the Examiner merely infers that this is likely. Appellants disagree.

App. Br. 10.

The Examiner responds by citing column 5, lines 1-6 of Clynch and asserting that:

> It is well known to one of ordinary skill in the art, at the time of the invention, that there has to be an interaction between the patient and the physician, and physician would obtain at least one patient attribute (such as patient's weight, height, size and shape of the desired prosthetic medical device, or patient's activity level).

Answer 26. The Examiner also cites column 7, lines 24-65 and Fig. 3 to teach the querying step. Answer 27-28.

"Anticipation requires disclosure of each and every claim limitation in a single prior art reference, either explicitly or inherently." *In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1371 (Fed. Cir. 2007). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999)).

Column 5, lines 1-6 of Clynch (FF 1) does not expressly describe the claimed step of interviewing a patient having a need for a medical device to determine at least one patient attribute, which is then used to query the claimed digital repository. Column 7, lines 22-65 of Clynch also does not describe using the patient attribute, which was obtained in the interviewing, to query a digital repository. Column 7, lines 22-65 of Clynch describe using a pull down menu to select default modifications, which are stored in a database and are made to the scanned image (FF 2), but does not describe a query for a subset of medical device components based on the at least one patient attribute. The Examiner has not established that the claimed interviewing step which determines at least one patient attribute that is used to query the digital repository is expressly or inherently present. Accordingly, we find that the Appellants have overcome the rejection of claims 31 and 65, and claims 32-37, 39, 66, 67, and 82, dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Clynch.

Independent claim 46 recites an apparatus, unlike the method of claims 31 and 65, which includes "means for interviewing a patient having a

need for a medical device to determine at least one patient attribute" and "means for querying the digital repository for a subset of medical device components based on the at least one patient attribute." The Examiner rejected claim 46 using the same rationale as to reject claims 32 and 65. Answer 6. Again, we find that the cited passages do not expressly describe the claimed means for interviewing and means for querying and that the Examiner has not established that the Clynch inherently describes these means. Accordingly, we find that the Appellants have overcome the rejection of claim 46, and claims 47 and 48, dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Clynch.

*The rejection of claims 1-5, 8-14, 16, 19, 20, 22-30, and 80-81 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and DeBusk.*

Independent claim 1 recites an apparatus which includes "a patient interview mechanism configured to receive over the network the at least one patient interview answer indicator corresponding to an attribute of a patient" and "a configurator mechanism configured to select a subset of entries from a digital repository based on the at least one patient interview answer indicator in memory."

In rejecting independent claim 1, the Examiner relies upon the same rationale as discussed above. Answer 10. The Examiner does not rely upon DeBusk to teach these limitations or provide any explanation, other than citing to Clynch. *See* Answer 10-11. Accordingly, for the reasons discussed above, we find that the Appellants have overcome the rejection of claim 1, and claims 2-5, 8-24, 16, 19, 22-30, and 80-81, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Clynch and DeBusk.

*The rejection of claims 38 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Vanker and the rejection of claims 68 and 69 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Haller.*

Claims 38, 49, 68, and 69 depend from independent claims 38, 46, and 65, whose rejection we have reversed above. In rejecting claims 38, 49, 68, and 69, the Examiner does not rely upon Vanker or Haller to teach the limitations at issue above. *See* Answer 29-21. Accordingly, we find that the Appellants have overcome the rejection of claims 38 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Vanker and the rejection of claims 68 and 69 under 35 U.S.C. § 103(a) as being unpatentable over Clynch and Haller.

*The rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Vanker and the rejection of claims 15, 17, 18, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Haller.*

Claims 6, 7, 15, 17, 18, and 21 depend from independent claim 1, whose rejection we have reversed above. In rejecting claims 6, 7, 15, 17, 18, and 21, the Examiner does not rely upon Vanker or Haller to teach the limitations at issue above. *See* Answer 22-26. Accordingly, we find that the Appellants have overcome the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Vanker and the rejection of claims 15, 17, 18, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Clynch, DeBusk, and Haller.

## DECISION

The decision of the Examiner to reject claims 1-39, 46-49, 65-69, and 80-82 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED

mev

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